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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/679,749
Filing Date: October 06, 2003
Appellant(s): FLAGSTAD, GEOFFREY

George Wheeler
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 1/24/08 appealing from the Office action mailed 11/28/07.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

2001/0041991	Segal et al.	11-2001
6,283,761	Joao	9-2001
2003/0140044	Mok et al.	7-2003

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Notice to Applicant

1. This communication is in response to the Appeal Brief filed on 9/17/07. Claims 3-4 have been cancelled. Claims 1-2 and 5-64 are pending.

Pre-Appeal Brief

2. In view of the Appeal Brief filed on 9/17/07, the FINAL REJECTION IS HEREBY WITHDRAWN. New grounds of rejection are set forth below.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

- (A) Claims 1-2 and 5-64 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. More specifically, claims 1-2 and 5-64 are directed to non-statutory subject matter because these claims subvert existing federal statutes, such as the Health Insurance Portability and Accountability Act of 1996 (HIPAA), through the use of the patent system and therefore, are against public policy.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2, 5-8, 11-32, 35-46, and 49-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Segal (US 2001/0041991; hereinafter Segal), in view of Joao (6,283,761; hereinafter Joao), and in view of Official Notice.

(A) As per previously presented claim 1, Segal discloses a method for a service provider to obtain a medical record of a patient from a covered entity in a form allowing said service provider to quickly disclose said medical record to a third party without restriction by the Health Insurance Portability and Accountability Act of 1996, the method comprising the following steps carried out by a service provider that is not the patient or a covered entity:

- (1) inducing said patient to receive said medical record from a covered entity (Segal: pg. 2, par. [0014]; pg. 12, par. [0151]) (Examiner notes Segal teaches that the patient has ownership and control of their medical records. As such, other parties interested in acquiring a medical record from a patient would be required to induce the patient to obtain their medical records for them.);
- (2) receiving said medical record from said patient in a storage format, without data processing said medical record (Segal: pg. 12, par. [0012]); and
- (3) storing said medical record in a memory in a form from which said medical record can be reproduced in said storage format (Segal: pg. 12, par. [0012]).

Segal, however, fails to expressly disclose a method for a service provider to obtain a medical record of a patient from a covered entity in a form allowing said service provider to quickly disclose said medical record to a third party without restriction by the Health. Insurance

Portability and Accountability Act of 1996, the method comprising the following steps carried out by a service provider that is not the patient or a covered entity:

- (4) storing said medical record without data processing said medical record [Emphasis added];
- (5) obtaining agreement in advance with the patient that the service provider shall transmit said medical record to a third party under defined conditions; and
- (6) transmitting said medical record to a third party when the defined conditions occur, without data processing said medical record.

Nevertheless, these features are old and well known in the art, as evidenced by Joao and Official Notice. In particular, Joao and Official Notice disclose a method for a service provider to obtain a medical record of a patient from a covered entity in a form allowing said service provider to quickly disclose said medical record to a third party without restriction by the Health Insurance Portability and Accountability Act of 1996, the method comprising the following steps carried out by a service provider that is not the patient or a covered entity:

- (4) storing said medical record without data processing said medical record (Joao: col. 2, lines 26-30; col. 3, lines 25-45; col. 4, lines 27-33; col. 6, lines 52-56);
- (5) obtaining agreement in advance with the patient that the service provider shall transmit said medical record to a third party under defined conditions (Official Notice: Examiner takes Official Notice that the technique of having one party (e.g., intermediary, middle man, straw man, etc.) perform certain actions on behalf of another party through an agreement is notoriously well known and obvious. For example, a power of attorney, a proxy agreement, and executor/trustee agreements, are commonly used to obtain an agreement in advance between multiple parties to consummate an agreed course of action (e.g., transmission of medical records,

etc.). Moreover, these techniques were developed and used prior to Applicant's invention to facilitate transactions.); and

(6) transmitting said medical record to a third party when the defined conditions occur, without data processing said medical record (Official Notice: See step (5) above.).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Joao with the combined teachings of Segal and Official Notice with the motivation of providing healthcare information to pertinent parties (Joao: col. 7, lines 61-65).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Official Notice with the combined teachings of Segal and Joao with the motivation of facilitating transactions.

(B) As per previously presented claim 2, Segal discloses the method of claim 1, further comprising:

said service provider inducing said patient to obtain possession of said medical record from said covered entity in a first format and said service provider inducing said patient to convert said medical record to said storage format, wherein said storage format is different from said first format (Segal: pg. 3, par. [0027]) Examiner notes Segal teaches a patient, "with guidance from their physician," obtaining their medical record in a first format (i.e., hard copy) and converting said medical record into a storage format (i.e., digital format via computer data entry).

(C) As per original claim 5, Segal discloses the method of claim 1, wherein:
said memory is a portable medium (Segal: pg. 12, par. [0151]).

(D) As per original claim 6, Segal discloses the method of claim 5, wherein" said portable

medium is an optical disc (Segal: pg. 12, par. [0151]).

(E) As per original claim 7, Segal discloses the method of claim 1, further comprising:
retrieving said medical record stored in said memory remotely through a computer
communications network (Segal: Fig. 1).

(F) As per previously presented claim 8, Segal discloses the method of claim 1, further
comprising:

said service provider inducing said patient to update said medical record stored in said
memory (Segal: pg. 12, par. [0151]).

(G) As per original claim 11, Segal discloses the method of claim 1, wherein:
said medical record is stored in a hierarchical storage system (Segal: Fig. 2a).

(H) As per original claim 12, Segal discloses the method of claim 11, wherein:
said medical record is assigned to at least one file folder, said file folder containing medical
records sharing at least one common attribute (Segal: Fig. 2a).

(I) As per original claim 13, Segal discloses the method of claim 12, wherein:
said file folder is assigned to at least one file template, said file template containing file folders
sharing at least one common attribute (Segal: Fig. 2a).

(J) As per original claim 14, Segal discloses the method of claim 13, wherein:
a plurality of said file templates are stored in said storage system to form a
general medical and personal information file of said patient (Segal: pg. 3, par. [0027]; Fig. 2a).

(K) As per original claim 15, Segal discloses the method of claim 12, wherein:
said file folder further comprises at least one sub-folder (Segal: Fig. 2a).

(L) As per original claim 16, Segal discloses the method of claim 11, wherein:

said hierarchical storage system provides hierarchical storage access (Segal: pg. 9, par. [0012]).

Examiner notes also that, as a standard feature, data storage and operating systems (e.g., Microsoft Windows) enable a user to define multi-level access parameters to user designated files, folders, drives, databases, and/or applications, among other items.

(M) " As per original claim 17, Segal discloses the method of claim 14, wherein:

access to a special file template is on a different basis than access to at least one other file template (Segal: pg. 9, par. [0012]). Examiner notes also that, as a standard feature, data storage and operating systems (e.g., Microsoft Windows) enable a user to define multi-level access parameters to user designated files, folders, drives, databases, and/or applications, among other items.

(N) As per original claim 18, Segal discloses the method of claim 7, wherein:

said special file template is an emergency file template (Segal: Fig. 2a).

(O) As per original claim 22, Segal discloses the method of claim 20, wherein:

said system is provided in the form of software (Segal: pg. 3, par. [0022]).

(P) Claims 19-21 and 23-29 substantially repeat the same limitations of claims 1, 2, 5-11 and 16, and therefore, are rejected for the same reasons given for those claims and incorporated herein.

(Q) Currently amended claim 30 substantially repeats the same limitations as amended claims 1 and 2 and therefore, is rejected for the same reasons given for those claims and incorporated herein.

(R) As per original claim 32, Segal discloses the system of claim 30, wherein:

said communication interface is adapted for acquiring said medical record from said patient in said storage format (Segal: pg. 7, par. [0099]; pg. 12, par. [0146]; Fig. 1 and Fig. 4).

(S) As per original claim 46, Segal discloses the system of claim 44, wherein:
said special file template is stored in a first memory and said general medical information file is stored in a second memory wherein said first and second memories are different optical discs (Segal: pg. 4, par. [0030]; Fig. 1).

(T) Claims 31, 35-45 and 47-49 substantially repeat the same limitations of claims 3- 7, 8-18 and 20, and therefore, are rejected for the same reasons given for those claims and. incorporated herein.

(U) As per previously presented claim 50, Segal discloses the method of claim 1, wherein said medical record is made by the covered entity before said inducing (Segal: par. [0121]).

(V) As previously presented claim 51, Segal discloses the method of claim 1, wherein said inducing occurs before the patient obtains possession of the medical record (Segal: par. [0024], [0027] and [0121]).

(W) As per previously presented claim 52, Segal discloses the method of claim 1, wherein the patient obtains possession of the medical record before said acquiring (Segal: par. [0121]).

(X) As per previously presented claim 53, Segal discloses the method of claim 1, wherein the patient has a computer with Internet access, and said inducing further comprises said service provider inducing said patient to obtain possession in said patient's computer of said medical record in digital form from a covered entity (Segal: par. [0024], [0026], [0027] and [0108], fig. 1).

(Y) As per previously presented claim 54, Segal discloses the method of claim 1, further comprising said service provider inducing said patient to acquire said medical record in a digital storage format without intervention of any entity or person other than said covered entity (Segal:

Segal: par. [0024], [0026], [0027] and [0108], fig. 1).

(Z) Claims 55-64 substantially repeat the same limitations as those recited in claims 50-54 and therefore, are rejected for the same reasons given for those claims and incorporated herein.

6. Claims 33 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Segal, Joao, and Official Notice, as applied to claim 1 above, and further in view of Judson et al. (US 2005/0026117; hereinafter Judson).

(A) As per original claim 33, Segal discloses system of claim 30, wherein: said communication interface is adapted to obtain the agreement of said patient to allow transmission of said medical record to a health care provider (Segal: pg. 3, par. [0028]). Segal, however, fails to expressly disclose the system of claim 30, wherein: under defined conditions.

Nevertheless, this feature is old and well known in the art, as evidenced by Judson. In particular, Judson discloses the method of claim 1, further comprising: under defined conditions (Judson: pg. 8, par. [0105]).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Judson within the combined teachings of Segal, Joao, and Official Notice with the motivation of managing a user's (e.g., patient) medical data (e.g., genomic data) (Judson: pg. 1, par. [0010]).

(B) As per original claim 34, Segal fails to expressly disclose the system of claim 30, wherein:

communication interface is adapted to obtain said agreement before a defined condition arises.

Nevertheless, this feature is old and well known in the art, as evidenced by Judson. In particular, Judson discloses the method of claim 3, further comprising:

said agreement is obtained before a defined condition arises (Judson: pg. 8, par. [0105]).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Judson with the combined teachings of Segal, Joao, and Official Notice with the motivation of managing a user's (e.g., patient) medical data (e.g., genomic data) and decreasing unauthorized access to medical data (Judson: pg. 1, par. [0010] and pg. 8, par. [0105]).

7. Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Segal, Joao, and Official Notice, as applied to claim 1 above, and further in view of Mok et al. (US 2003/0140044; hereinafter Mok).

(A) As per previously presented claim 9, Segal fails to expressly disclose the method of claim 1, further comprising:

said service provider inducing said patient to provide other information that is not a medical record, and storing said other information in said memory.

Nevertheless, this feature is old and well known in the art, as evidenced by Mok. In particular, Mok discloses the method of claim 1, further comprising:

said service provider inducing said patient to provide other information that is not a medical record, and storing said other information in said memory (Mok: pg. 14, par. [0127]).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Mok with the combined teachings of Segal, Joao, and Official Notice with the motivation of including other types of records where a person needs his/her records collected (Mok: pg. 14, par. [0127]).

(B) As per original claim 10, Segal fails to expressly disclose the method of claim 9, wherein: said other information comprises information selected from the group consisting of a living will, investment portfolio, life insurance and a credit arrangement.

Nevertheless, this feature is old and well known in the art, as evidenced by Mok. In particular, Mok discloses the method of Claim 9, wherein:

said other information comprises information selected from the group consisting of a living will, investment portfolio, life insurance and a credit arrangement (Mok: pg. 14, par. [0127]) (The Examiner has noted insofar as claim 10 recites "selected from the group consisting of a living will, investment portfolio, life insurance and a credit arrangement," an investment portfolio has been recited.).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Mok with the combined teachings of Segal, Joao, and Official Notice with the motivation of including other types of records where a person needs his/her records collected (Mok: pg. 14, par. [0127]).

(10) Response to Argument

In the Appeal Brief filed 24 January 2008, Appellant makes the following arguments:

(A) The arguments regarding the rejection under 35 U.S.C. § 101.

(B) Taken together, the references applied in the rejections based on the combination of the teachings of Segal and Joao fail to disclose a service provider storing a medical record without data processing said medical record.

(C) The combination of references is inappropriate because Segal explicitly teaches a step of data processing and is not properly combined with a reference that teaches a lack of data processing.

(D) It was inappropriate to rely on the Official Notice that transmitting medical records without data processing was old and well-known in the art, without any prior art of record cited as having taught this limitation.

(E) It was error to treat certain matters taken on Official Notice as admitted prior art when the Applicant adequately traversed the use of Official Notice.

Examiner will address Appellant's arguments in sequence as they appear in the brief.

Response to Argument (A):

In response to the first argument, the rejection under 35 U.S.C. § 101 has been withdrawn by the Examiner based on the arguments made by the Appellant.

Response to Argument (B):

In response to the second argument, the Examiner respectfully submits first that Segal teaches that the patient provides his or her medical record to the service provider on a portable storage medium (e.g., medical bracelets, smart cards, etc.) so that the service provider could download the information into service provider's system--until the service provider actually downloads the patient's medical record and modifies it, NO "data processing" has occurred (Segal: pg. 12, ¶ [0151]).

Second, assuming *arguendo* that Segal does not teach storing a medical record without data processing, Joao clearly teaches storing medical records on storage mediums, such as smart cards. Moreover, Joao teaches that any of the entities, including service providers, may possess

these portable medical records that have not been "processed" (Joao: col. 39, line 53-col. 40, line 2). Furthermore, Joao teaches that these portable medical records may be read (i.e., read without data processing) by appropriate reading devices (Joao: col. 40, lines 3-12). Lastly, even if these passages could be construed to disclose that "data processing" occurs after providing the portable medical record to the service provider, the fact remains the Joao clearly teaches 1) that the patient may possess the non-data-processed portable medical record (Joao: col. 39, lines 53-63) and 2) that any patient, user, provider, payer, and/or intermediary, may utilize the present invention in the same, similar and/or analogous manner (Joao: col. 4, lines 26-33). In other words, a service provider may possess the non-data-processed portable medical record in the same manner as the patient.

Response to Argument (C):

In response to the third argument, the Examiner respectfully submits that a broad, yet reasonable interpretation, of Joao does indeed teach the aforementioned features of Appellant's claimed invention.

For example, Joao teaches the following:

(i) The present invention provides an apparatus and methods for providing healthcare information and/or healthcare-related information which overcomes the shortcomings of the prior art [Emphasis added]. See Joao: col. 2, lines 26-30.

(ii) The apparatus also includes an intermediary communication device or computer which is associated with an intermediary, a broker, an agent, and/or any other individual and/or entity, that can utilize the present invention **in order to act for and/or on behalf of any other individual, party, or entity, described herein**. The intermediary

computer(s) can communicate with, and operate in conjunction with, central processing computer systems described herein [Emphasis added]. See Joao: col. 3, lines 26-33.

(iii) Each of the central processing computer(s), the provider computer(s), the payer computer(s), the patient computer(s), and/or the intermediary computer(s), **can** transmit information to, as well as receive information from, any of the computers described herein. In this regard, each of the computers **can** communicate with, process information from, and/or share data and/or information with, each other and/or any other computer or computers described herein and/or utilized in conjunction with the present invention. In this manner, data and/or **information transfer between any of the computers can take place in a bi-directional manner** [Emphasis added]. See Joao: col. 3, lines 34-45.

(iv) The apparatus and method of the present invention can be utilized in **numerous preferred embodiments** in order to provide a vast array of healthcare and healthcare-related services for any one or more of the various parties described herein. **Any patient, user, provider, payer, and/or intermediary, may utilize the present invention in the same, similar and/or analogous manner** [Emphasis added]. See Joao: col. 4, lines 27-33.

First, Joao teaches, in passage excerpt (i), *supra*, that his invention provides an apparatus and methods for "**providing** healthcare information" without mentioning "data processing" [Emphasis added]. Although Joao does later teach that the present invention also provides an apparatus and a method for providing a comprehensive "processing system," this feature (i.e., processing) is merely another embodiment.

Second, contrary to Appellant's arguments, Joao does not exclusively teach that "data processing" must occur, should occur, and/or is occurring. Rather, Joao teaches multiple embodiments including an embodiment where no "data processing" occurs, as evidenced by Joao's use of alternative language, such as "can" and "and/or," as emphasized in passage excerpts (i)-(iv), *supra*. In other words, a broad, yet reasonable, interpretation of these Joao passages teaches that "data processing" is optional.

Third, Joao teaches, in passage excerpt (i), *supra*, "Any patient, user, provider, payer, and/or intermediary, may utilize the present invention in the same, similar and/or analogous manner." Therefore, a broad, yet reasonable, interpretation of Joao, would include a teaching where a service provider, who is not the patient or a covered entity, may utilize the invention as if the service provider were a patient (i.e., a ,party who provides and/or stores a medical record with data processing).

In short, Examiner respectfully submits that Joao does indeed teach the aforementioned features of Appellant's claimed invention.

Response to Arguments (D) and (E):

In response to the fourth and fifth arguments, the Examiner respectfully submits that **in order to adequately traverse** such an Official Notice finding, an Appellant must specifically point out the supposed errors in the examiner's action, which would include **stating why the noticed fact is not considered to be common knowledge or well-known in the art** [Emphasis added]. See 37 CFR 1.111(b). See *also Chevenard*, 139 F.2d at 713, 60 USPQ at 241 ("[I]n the absence of any demand by appellant for the examiner to produce authority for his statement, we will not consider this contention.").

Moreover, if Appellant does not traverse the Examiner's assertion of Official Notice or Appellant's traverse is not adequate, the Examiner should clearly indicate in the next Office Action that the common knowledge or well-known in the art statement is taken to be admitted prior art because Appellant either failed to traverse the Examiner's assertion of Official Notice or that the traverse was inadequate. If the traverse was inadequate, the Examiner should include an explanation as to why it was inadequate.

Accordingly, Examiner respectfully submits that Appellant's traverse of Official Notice was inadequate because Appellant did not state why the noticed fact is not considered to be common knowledge or well-known in the art. As such, the features rejected via Official Notice are deemed to be admitted prior art.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Robert Morgan/
Primary Examiner, Art Unit 3626
Robert Morgan
Primary Patent Examiner
Tech Center 3600

Conferees:

Art Unit: 3600

/CLG/

Luke Gilligan

Supervisory Patent Examiner

Tech Center 3600

Vincent Millin /VM/

Appeals Practice Specialist